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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/555,709	07/19/2000	ANDREAS FERENCZ	H2933/3578UA	9120

7590 05/01/2003

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EXAMINER

SHORT, PATRICIA A

ART UNIT	PAPER NUMBER
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1712

19

DATE MAILED: 05/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 09/555709	Applicant(s) Ferez et al.
Examiner Short	Group Art Unit 1712

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- Responsive to communication(s) filed on February 26, 2003
- This action is **FINAL**.
- Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- Claim(s) 1, 19-50 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- Claim(s) _____ is/are allowed.
- Claim(s) 1, 19-50 is/are rejected.
- Claim(s) _____ is/are objected to.
- Claim(s) _____ are subject to restriction or election requirement

Application Papers

- The proposed drawing correction, filed on _____ is approved disapproved.
- The drawing(s) filed on _____ is/are objected to by the Examiner
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- All Some* None of the:
 - Certified copies of the priority documents have been received.
 - Certified copies of the priority documents have been received in Application No. _____
 - Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))
- *Certified copies not received: _____

Attachment(s)

- Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- Interview Summary, PTO-413
- Notice of Reference(s) Cited, PTO-892
- Notice of Informal Patent Application, PTO-152
- Notice of Draftsperson's Patent Drawing Review, PTO-948
- Other _____

Office Action Summary

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 23-37, 43 and 47 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The rejection is applied as in the previous Office Action. Applicant argues that the specification supports a sub-genus of aromatic-containing polyester for component A and points to the disclosure of polyesters prepared from a first aromatic acid, a second acid and an alcohol. The sub-genus aromatic containing polyester encompasses polyesters other than polyesters prepared from a first aromatic acid, a second acid and an alcohol, such as polyester prepared from an aromatic alcohol and aliphatic acid.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 19-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller. The rejection is applied as in the previous Office Action. Applicant argues that there is no motivation to combine two polyesters as required in the claims. While the reference does not exemplify an amorphous aromatic containing polyester having a molecular weight (M_n) of at least 8000 for use in the invention, in example 4, the amorphous aromatic containing polyester has a

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molecular weight (M_n) of 7,300. Further, the reference teaches that the adhesives can have a molecular weight (M_n) of as high as 20,000 and a preferred molecular weight (M_n) as high as 10,000. See col. 8, lines 47-54. When preparing the higher molecular weight adhesives of the reference, it would have been obvious to select amorphous aromatic containing polyester having a molecular weight (M_n) of greater than 8,000, not significantly higher than an exemplified molecular weight (M_n) of 7,300, and use in combination with lower molecular weight polyester, such as the exemplified polyesters, in order to obtain an increase in the molecular weight of the adhesive and improve tensile strength and peel strength.

With respect to new claims 48-50 applicant argues that the language “consisting essentially of” excludes the sulfonomers of Miller. However, it is not clear how the sulfonomers of Miller would materially affect the novel and basic characteristics of applicants’ invention as defined in the balance of the claim. See *In re Janakirama-Rao* 137 USPQ 893 (CCPA 1963). It is noted that the adhesive of Miller are useful in forming disposable nonwoven composites from polyolefin such as disposable diapers. See col. 2, lines 12-14 and col. 9, lines 16-20.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

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will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

P. Short

April 22, 2003

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**PATRICIA A. SHORT
PRIMARY EXAMINER**

Patricia A. Short